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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,527	12/20/2001	Yoji Matsuda	016907/1335	2170
22428	7590	11/30/2005	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			TEACHEY, ROBERT	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/022,527 ✓	Applicant(s) MATSUDA, YOJI	
	Examiner Robert Teachey	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/20/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant(s)

This application has been examined. Claims 1–20 are pending.

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The specification lists foreign patent document number 9-193501 (page 1 line 23). This document is not listed on the information disclosure statement and has been cited by the examiner on form PTO-892.

Claim Objections

2. Claim 4 is objected to because of the following informalities:

In lines 18-23 of the claim “when generating a number-of-sheets-used-information list or report every user group and coloring the data with a color designated by the user or character-modifying the data by a modification method designated by the user when the item meets the condition” can be logically interpreted in at least two different ways.

Appropriate correction is required.

3. Claims 7, 14, and 20 are objected to because of the following informalities:

It is unclear whether “stage” refers to the front stage of the image processing circuit (page 33 line 9), rear stage of the image processing circuit (page 33 line 12) or refers to some other physical or conceptual stage.

Appropriate correction is required.

4. Claim 20 is objected to because of the following informalities:

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The word "user" is misspelled therefore "color designated by the usr" (page 66 line 6) should be changed to "color designated by the user".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 4, 6, 7, 10, 11, 14, 16, 17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. It is unclear what is meant by "the data" (page 58 lines 11, 20, 21, 26; page 59 lines 1, 17, 27; page 60 line 5; page 61 lines 17; page 62 line 9; page 63 lines 8, 12-13; page 64 lines 16, 25, 27; page 65 lines 4, 6, 22; page 66 lines 5, 9) of claims 3, 4, 6, 7, 10, 11, 14, 16, 17, 19, and 20 because "the data" is ambiguous. The specification discloses "image data" (page 34 lines 12-13), "print data" (page 35 line 3), and "display data" (page 37 line 9).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 3, 5, 6, 8, 9, 10, 12, 13, 15, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozeki (U.S. Patent Re.34,835) in view of Takahashi et al. (hereinafter referred to as Takahashi) (U.S. Patent 6,281,893).

With respect to claim 1 Ozeki discloses an image-forming device comprising: a device-information-holding module which holds inherent device information including the control information to be possessed by the image-forming device (column 3 lines 50-68, column 4 lines 1-12); a condition-setting module which sets a reference value to specific device information in the above device information as a condition (column 5 lines 17-21); a character-data-generating module which fetches the device information from the device-information-holding module, determining whether the device information meets the condition set by the condition-setting module, adding predetermined color

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information to the device information in accordance with the determination result, and converting the device information added with the predetermined color information into character-string data (column 3 lines 20-29); an image-data-generating module which converts the character-string data converted by the character-data-generating module into character-image data (column 5 lines 36-49); an image-data-storing module which stores the character-image data converted by the image-data-generating module (column 5 lines 36-49); and an image-forming module which reads the character-image data from the image-data-storing module and forming an image based on the character-image data on an image-recording medium, wherein the image-forming module has a function for coloring and character-modifying the specific device information under a specific condition (column 5 lines 10-49).

The device disclosed by Ozeki differs from claim 1 in that it does not provide for printing out the information.

Takahashi discloses a device that provides for printing out the information (column 3 lines 39-40).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ozeki wherein Ozeki's device provides for printing out the information. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify

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Ozeki by the teaching of Takahashi so that the image can be transferred to a recording sheet (given the express suggestion of Takahashi column 3 lines 39-40).

10. With respect to claims 8 and 15, claims 8 and 15 are rejected for the same reasons as claim 1.

With respect to claim 2 Ozeki discloses an image-forming device further comprising a user interface which displays a condition to be set by the condition-setting module (column 11 lines 1-5).

11. With respect to claim 9, claim 9 is rejected for the same reasons as claim 2.

With respect to claim 3 Ozeki discloses an image-forming device further comprising a user interface which displays a condition to be set by the condition-setting module (column 7 lines 52-63).

12. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozeki in view of Takahashi. Claims 10 and 16 arguments are analogous to those presented for claim 3 therefore the arguments presented for claim 3 is applicable.

With respect to claim 5 Ozeki discloses an image-forming device wherein the image-data-generating module has a function for generating character-image data by applying respectively-inherent character modification to the specific device information under a plurality of conditions (column 5 lines 36-49).

The device disclosed by Ozeki differs from claim 5 in that it does not provide for printing out the character-image data by applying respectively-inherent character modification to the specific device information generated by the image-data-generating module under a plurality of conditions.

Takahashi discloses a device that provides for printing out the character-image data by applying respectively-inherent character modification to the specific device information generated by the image-data-generating module under a plurality of conditions (column 8 lines 48-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ozeki wherein Ozeki's device provides for provides for printing out the character-image data by applying respectively-inherent character modification to the specific device information generated by the image-data-generating module under a plurality of conditions. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Ozeki by the teaching of Takahashi so that the

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final image can be checked efficiently thus reducing unnecessary copies (given the express suggestion of Takahashi column 2 lines 22-23).

13. With respect to claims 12 and 18, claims 12 and 18 are rejected for the same reasons as claim 5.

With respect to claim 6 Ozeki discloses an image-forming device wherein the image-forming module has a function for stepwise coloring each of the character-image data values with an inherent color about one item (column 5 lines 24-49).

The device disclosed by Ozeki differs from claim 6 in that it does not provide for printing out the data correspondingly to a preset number of conditions when printing out the device information.

Takahashi discloses a device that provides for printing out the data correspondingly to a preset number of conditions when printing out the device information (column 8 lines 48-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ozeki wherein Ozeki's device provides for printing out the data correspondingly to a preset number of conditions when printing out the device information. It would have been obvious

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to one of ordinary skill in the art at the time of the applicant's invention to modify Ozeki by the teaching of Takahashi so that the final image can be checked efficiently thus reducing unnecessary copies (given the express suggestion of Takahashi column 2 lines 22-23).

14. With respect to claims 13 and 19, claims 8 and 15 are rejected for the same reasons as claim 6.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4, 7, 11, 14, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozeki in view of Takahashi as applied to claim 1 above, and further in view of Inoue et al. (hereinafter referred to as Inoue) (JP09-305576).

With respect to claim 4, Ozeki as modified discloses the image-forming module has a function for printing out character-image data by coloring the data with the color generated by the image-data-generating module and designated by the user or character-modifying the data by a modification method designated by the user (Takahashi column 8 lines 48-65).

With respect to claim 4, Ozeki as modified differs from claim 4 in that Ozeki as modified does not disclose the image-data-generating module has a function for generating character-image data by determining whether an item designated by a user meets a condition designated by the user when generating a number-of-sheets-used-information list or report every user group and coloring the data with a color designated by the user or character-modifying the data by a modification method designated by the user when the item meets the condition.

Inoue discloses the image-data-generating module has a function for generating character-image data by determining whether an item designated by a user meets a condition designated by the user when generating a number-of-sheets-used-information list or report every user group and coloring the data with a color designated by the user or character-modifying the data by a modification method designated by the user when the item meets the condition (paragraphs 0073, 0074).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ozeki as modified wherein the image-data-generating module has a function for generating character-image data by determining whether an item designated by a user meets a condition designated by the user when generating a number-of-sheets-used-information list or report every user group and coloring the data with a color designated by

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the user or character-modifying the data by a modification method designated by the user when the item meets the condition. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Ozeki as modified by the teaching of Inoue so that Ozeki's invention could improve work efficiency by printing additional information (given the express suggestion of Inoue (abstract section)).

17. With respect to claims 11 and 17, claims 11 and 17 are rejected for the same reasons as claim 4.

With respect to claim 7, Ozeki as modified by Takahashi discloses generating character-image data by coloring the data with a color designated by the user in accordance with a stage meeting one of the conditions, and the image-forming module has a function for printing out the character-image data by coloring the data with a color designated by the user in accordance with a stage meeting one of the conditions (Takahashi column 8 lines 48-68).

Ozeki as modified differs from claims 7 in that Ozeki as modified does not disclose an image-forming device wherein the image-data-generating module has a function for determining whether to meet any stage of a plurality of conditions designated by a user about one item designated by the user when generating a number-of-sheet-used-in-formation list or report every user group.

Inoue et al. discloses an image-forming device wherein the image-data-generating module has a function for determining whether to meet any stage of a plurality of conditions designated by a user about one item designated by the user when generating a number-of-sheet-used-in-formation list or report every user group (paragraphs 0073, 0074).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ozeki as modified wherein the image-data-generating module has a function for determining whether to meet any stage of a plurality of conditions designated by a user about one item designated by the user when generating a number-of-sheet-used-in-formation list or report every user group. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Ozeki as modified by the teaching of Inoue so that Ozeki's invention could improve work efficiency by printing additional information (given the express suggestion of Inoue (abstract section)).

18. With respect to claims 14 and 20, claims 14 and 20 are rejected for the same reasons as claim 7.

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Conclusion

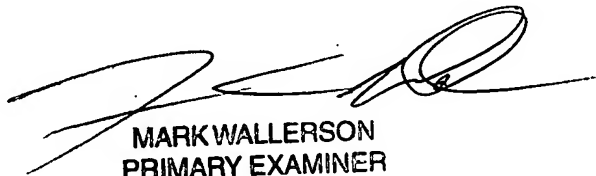
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Teachey whose telephone number is 571-272-2906. The examiner can normally be reached Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RT

Robert Teachey



MARK WALLERSON
PRIMARY EXAMINER